

REMARKS/ARGUMENTS

Applicants thank the Examiner for the thorough consideration given the present application. Claims 1-18 are pending in the present application. Claims 1, 6-8, 10, and 14 have been amended. Claims 15-18 are new. Claims 1 and 8 are independent claims. The Examiner is respectfully requested to reconsider his rejections in view of the Amendments and the following Remarks.

Drawings

It is gratefully acknowledged that the Examiner has accepted the Formal Drawings filed on July 26, 2001.

Rejection Under 35 U.S.C. § 102

Claims 1-14 stand rejected under 35 USC § 102(e) as being anticipated by U.S. Patent No. 6,738,825 to Bortolotto et al. (hereafter Bortolotto). This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

Initially, Applicants point out that MPEP § 2131 sets forth the following requirement for a proper rejection under 35 USC § 102:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art

reference." *Verdegaal Bros. V. Union Oil Co. Of California*, 814 F2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claims." *Richardson v. Suzuki Motor Co.*, 868 F2d 1226, 1236, 9 USQP2d 1913, 1920 (Fed. Cir. 1989).

It is respectfully submitted that Bortolotto does not set forth each and every element as defined in the claims.

Teachings of Bortolotto:

Bortolotto teaches a network element (NE) 10 capable of routing traffic across two high-bandwidth planes, e.g., between telecommunication networks (e.g., SONET) and data networks (e.g., metro or local area networks). Specifically, Bortolotto's NE includes telecommunication network interface subsystems 130 and data network interface subsystems 140, along with cross-connect (XC) unit 120 (col. 5, lines 26-38). In Bortolotto, the XC unit and the telecommunication and data network interface subsystems may be plug-in cards that are plugged into slots of a backplane 800 in the NE (col. 7, lines 9-23).

Bortolotto further discloses a centralized timing, control, and communications (TCC) subsystem 300, which may also be a plug-in card. Bortolotto discloses that the TCC card automatically detects and determines the type of new cards as they are connected to the backplane. Thereafter, the TCC card

sends provisioning data to the newly inserted card. See col. 8, lines 48-63.

Independent Claim 8:

Claim 8 recites receiving information from network elements of the optical network, and automatically detecting new equipment to be provisioned in the optical network based on the received information. Applicants respectfully submit that these features are not taught in Bortolotto.

Instead, Bortolotto expressly discloses that a TCC card within a particular network element (NE) detects new equipment (i.e., new plug-in cards) inserted in that NE (col. 8, lines 48-63). Bortolotto's TCC card sends provisioning data to the new cards based on this detection.

There is simply no teaching in Bortolotto that the TCC card in a particular NE performs equipment detection based on information received from other NE's in the optical network. Instead, Bortolotto teaches that detection is performed based only on information received from the NE's backplane (i.e., communications with the new card).

Accordingly, Bortolotto fails to teach or suggest automatically detecting new equipment based on information

received from other network elements of an optical network, as required by independent claim 8.

Independent Claim 1:

As amended, claim 1 recites detecting one of a plurality of network elements having new equipment to be provisioned. Applicants respectfully submit that Bortolotto fails to disclose this feature.

Applicants submit that support for this feature can be found in, e.g., the originally filed claims, Figs. 3A and 3B, and page 11 of the specification (describing that the network management system of the optical network detects new equipment as it is inserted in a TMO switch and, therefore, implicitly detects that the TMO switch includes new equipment).

As described above, Bortolotto discloses that the TCC card within an NE detects new cards, which are inserted in that NE's backplane slots. The TCC card sends provisioning data to the card in response this detection. As such, Bortolotto fails to disclose that any external device or entity detects that the NE has received a new card requiring provisioning data.

Accordingly, Bortolotto fails to teach detecting one of a plurality of network elements in an optical network having new equipment to be provisioned, as required by claim 1.

Claims 1-14 Allowable Over Bortolotto:

Applicants respectfully submit that independent claims 1 and 8 are allowable at least for the reasons set forth above. Accordingly, it is respectfully submitted that claims 2-7 and 9-14 are allowable at least by virtue of their dependency on claims 1 and 8.

New Claims

Claims 15-18 are new. It is respectfully submitted that the filing of these claims add no new matter to the present application.

No Prosecution History Estoppel

Various clarifying amendments have been made to independent claim 8. It is respectfully submitted that these claims are merely editorial in nature, and do not substantively change the scope of the claimed subject matter. Also, Applicants submit that these amendments were not made for any reason relating to patentability. As such, these clarifying amendments do not give rise to any estoppel, and claim 8 is entitled to their full range of equivalents during future consideration.

Furthermore, it is respectfully submitted that claims 10 and 14 have been amended to correct minor typographical errors.

Claims 1-14 Allowable Over Bortolotto:

Applicants respectfully submit that independent claims 1 and 8 are allowable at least for the reasons set forth above. Accordingly, it is respectfully submitted that claims 2-7 and 9-14 are allowable at least by virtue of their dependency on claims 1 and 8.

New Claims

Claims 15-18 are new. It is respectfully submitted that the filing of these claims add no new matter to the present application.

No Prosecution History Estoppel

Various clarifying amendments have been made to independent claim 8. It is respectfully submitted that these claims are merely editorial in nature, and do not substantively change the scope of the claimed subject matter. Also, Applicants submit that these amendments were not made for any reason relating to patentability. As such, these clarifying amendments do not give rise to any estoppel, and claim 8 is entitled to their full range of equivalents during future consideration.

Furthermore, it is respectfully submitted that claims 10 and 14 have been amended to correct minor typographical errors.

It is submitted that such amendments do not effectively change the scope of the claims and, as such, do not give rise to any estoppel.

Conclusion

Since the remaining patents cited by the Examiner have not been utilized to reject the claims, but to merely show the state of the art, no comment need be made with respect thereto.

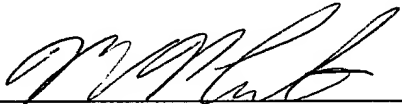
In view of the above remarks, the Examiner is respectfully requested to reconsider the outstanding rejections and issue a Notice of Allowance in the present application.

Should the Examiner believe that any outstanding matters remain in the present application, the Examiner is respectfully requested to contact Jason W. Rhodes (Reg. No. 47,305) at the telephone number of the undersigned to discuss the present application in an effort to expedite prosecution.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 
Michael R. Cammarata, #39,341

MRC/JWR

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000